



PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 089229.00039
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed Name _____	Application Number: 10/534,131	Filed: May 6, 2005
	First Named Inventor:	
	Antti TÖLLI	
	Art Unit: 2617	
		Examiner: William D. Cumming

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.
☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed

☒ Attorney or agent of record.
Registration No. 47,818

☐ Attorney or agent acting under 37 CFR 1.34.
Reg. No. is acting under 37 CFR 1.34 _____

Signature

David D. Nelson

Typed or printed name

703.720.7876

Telephone number

February 4, 2008

Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Confirmation No.: 8472

Antti TÖLLI

Art Unit: 2617

Serial Number: 10/534,131

Examiner: William D. Cumming

Filed: May 6, 2005

Atty. Docket No.: 089229.00039

For: METHOD AND A SYSTEM FOR SELECTING NON-REAL-TIME USERS TO
PERFORM CELL RESELECTION

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

February 4, 2008

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program guidelines set forth in the Official Gazette Notice of July 12, 2005, Applicant hereby submits this Pre-Appeal Brief Request for Review of the final rejections of claims 1-7 and 25 in the above identified application. Claims 1-7 and 25 were finally rejected in the Office Action dated October 4, 2007. Applicant filed a Response to the Final Office Action on December 4, 2007, and the Office issued an Advisory Action dated January 2, 2008 maintaining the final rejections of claims 1-7 and 25. Applicant hereby appeals these rejections and submit this Pre-Appeal Brief Request for Review.

In particular, the Office Action rejected claims 1-7 and 25 under 35 U.S.C. §102(a) as being anticipated by the publication "Performance Evaluation of Common Radio Resource Management (CRRM) to Tölli et al. (Tölli). Tölli was presented in the 2002 IEEE International Conference on Communications from April 28-May 2, 2002, and became publicly available sometime afterwards. Regardless of the original

publication date, this rejection is respectfully traversed because Tölli is not prior art to the present application under 35 U.S.C §102(a).

Applicant respectfully note that Antti Tölli is the sole named inventor in the present application and is the lead author in Tölli. Applicants submit that Tölli is not available as prior art under 35 U.S.C. §102(a) because the inventor of the present application authored the substantive portions of Tölli, identified as allegedly anticipatory. This fact was originally presented in the Response filed July 13, 2007, but the pending final Office Action stated since Tölli included multiple authors, the reference could be considered “of another” for purposes of 35 U.S.C. §102(a). This statement was not made in the previous Office Action dated April 30, 2007, and therefore a prima facie case had not been made under MPEP §2132.01. Applicant submitted a declaration under 37 C.F.R. §1.131 in response to these statements contained in the final Office Action. Thus, the Declaration should be considered under 37 C.F.R §116(b) because the declaration was made in response to the statements in the Office Action and could not be submitted before a prima facie case was presented in the Office Action.

In particular, the Declaration stated that Mr. Tölli, the sole inventor of the present application, authored the subject matter of Tölli relied upon in the Office Action to reject claims 1-7 and 25. Thus, Tölli is not authored by “another” as required under 35 U.S.C. 102(a). In particular, the Declaration contained a statement from the Applicant that the subject matter of Tölli was developed by Applicant, and the substantive portions of the article which relate to the subject matter of U.S. Patent Application Serial No. 10/534,131, were authored by Applicant. Mr. Hakalin and Mr. Holma are named on the paper due to their collaboration; however, the pertinent subject matter of the article was developed by Applicant, and Applicant alone. Accordingly, withdrawal of the rejection under 35 U.S.C. 102(a) is respectfully requested.

As described in MPEP §2132.01, Applicant can rebut the prima facie case by showing reference's disclosure was derived from **Applicant's own work**. In particular, Applicant's disclosure of his own work within the year before the application filing date

cannot be used against him or her under 35 U.S.C. §102(a), citing to In re Katz, 687 F.2d 450, 215 USPQ 14 (CCPA 1982). Therefore, where the Applicant is one of the co-authors of a publication cited against his or her application, the publication may be removed as a reference by the filing of a disclaiming affidavit establishing that the relevant portions of the publication originated with, or were obtained from, Applicant. Ex parte Hirschler, 110 USPQ 384 (Bd. App. 1952). The rejection can also be overcome by submission of a specific declaration by the Applicant establishing that the article is describing Applicant's own work. In re Katz, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

In In re Katz, 687 F.2d 450, 215 USPQ 14 (CCPA 1982), Katz stated in a declaration that the coauthors of the publication were students working under the direction and supervision of the inventor. The court held that this declaration, in combination with the fact that the publication was a research paper, was enough to establish Katz as the sole inventor and that the work described in the publication was his own. The present situation provides an analogous situation in which a sole inventor describes his own contribution to Tölle.

There is no evidence or allegations that the co-authors in Tölle have refused to disclaim inventorship and believe themselves to be an inventor, so Applicant's affidavit should be enough to establish that Applicant is the sole inventor.

Furthermore, Tölle is not a statutory bar under 35 U.S.C. §§102(b), (c), or (d), so Applicant can overcome the rejection under §102(a) by swearing back of the reference through the submission of the Declaration was formally submitted under 37 CFR §1.131, as described in MPEP §2132.01. In re Foster, 343 F.2d 980, 145 USPQ 166 (CCPA 1965). As described in the Declaration, Tölle is disclosing applicant's own work as derived from him or her to antedate the reference. In re Facius, 408 F.2d 1396, 161 USPQ 294 (CCPA 1969).

Based on the above, Applicants respectfully submit that each of claims 1-7 and 25 are in condition for allowance. Accordingly, it is respectfully requested that each of claims 1-7 and 25 be allowed, and this application passed to issue.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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Enclosures: PTO/SB/33 Form
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